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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,516	03/01/2002	Cliff Roth	GIST-005/01US	4083
22903	7590	02/14/2006	EXAMINER	
COOLEY GODWARD LLP ATTN: PATENT GROUP 11951 FREEDOM DRIVE, SUITE 1700 ONE FREEDOM SQUARE- RESTON TOWN CENTER RESTON, VA 20190-5061			LEROUX, ETIENNE PIERRE	
			ART UNIT	PAPER NUMBER
			2161	
DATE MAILED: 02/14/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/087,516	ROTH ET AL.	
	Examiner	Art Unit	
	Etienne P LeRoux	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5-21 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-21 and 23-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

*Status of the Claims*

Claims 1, 2 and 5-21 and 23-27 are pending; claims 3, 4 and 22 have been canceled.

Claims 1, 2 and 5-21 and 23-27 are rejected as detailed below.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 5-15 and 18-21 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub No 2003/0131355 issued to Berenson et al (hereafter Berenson) in view of US Pat No 5,828,419 issued to Bruette et al (hereafter Bruette).

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Claims 1, 5 and 19:

Berenson discloses:

receiving a request from a user to generate a recommendation guide [paragraph 23]

retrieving category preferences associated with the user [paragraph 39]

retrieving a list of preferred program indicators, wherein the preferred program indicators correspond to programs of interest selected by the user [Fig 1 and paragraphs 32-39]

retrieving a list of recommended program indicators [paragraph 83] the program indicators included in the list of recommended program indicators corresponding to at least one of the retrieved category preferences, wherein the recommended program indicators correspond to programs recommended to the user by a third party;

generating a list of displayable program indicators [Figs 7-9] wherein the list of displayable program indicators includes program indicators included in the list of preferred program indicators and program indicators included in the list of recommended program indicators but not included in the list of restricted program indicators [paragraph 42]

displaying program indicators included in the generated list of displayable program indicators, wherein the displayed program indicators are arranged according to the retrieved category preferences [Figs 7-9, paragraph 63].

Berenson discloses the essential elements of the claimed invention as noted above but fails to disclose retrieving a list of restricted program indicators. Bruette discloses retrieving a list of restricted program indicators [col 4, lines 57-65]. It would have been obvious to one of ordinary

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skill in the art at the time the invention was made to modify Berenson to include retrieving a list of restricted program indicators as taught by Bruette for the purpose of excluding certain programs from the guide [col 4, lines 57-60]. The skilled artisan would have been motivated to modify Berenson per the above such that children are not able to view adult programs.

Claim 2:

The combination of Berenson and Bruette disclose the elements of claim 1 as noted above and furthermore, Berenson discloses transmitting the generated list of displayable program indicators to a set-top box associated with the user [paragraph 37]

Claim 6:

The combination of Berenson and Bruette discloses the elements of claim 5 as noted above and furthermore, Berenson discloses displaying the retrieved program data for a first program indicator included in the list of displayable program indicators, wherein the retrieved program data for the first program indicator is displayed in association with a first category included in the plurality of category preferences, wherein the first category corresponds with the first program indicator [category 1, Fig 7]

Claim 7:

The combination of Berenson and Bruette discloses the elements of claim 5 as noted above and furthermore, Berenson discloses displaying the retrieved program data for a second program indicator included in the list of displayable program indicators, wherein the retrieved program data for the second program indicator is displayed in association with a first category

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included in the plurality of category preferences, wherein the second category corresponds with the second program indicator [category 2, Fig 7].

Claim 8:

The combination of Berenson and Bruette discloses the elements of claims 5-7 as noted above and furthermore, Berenson discloses displaying the first program indicator and an indicator of the first category in a row; and displaying the second program indicator and an indicator of the second category in a second row, however, Berenson does not disclose displaying the first program indicator and an indicator of the first category in a first column; and displaying the second program indicator and an indicator of the second category in a second column. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include displaying the first program indicator and an indicator of the first category in a first column; and displaying the second program indicator and an indicator of the second category in a second column for the purpose of placing the time axis in the first column. The skilled artisan would have been motivated to modify the above combination of references per the above such that the program guide prominently discloses program time and thus makes the program more easy to read.

Claim 9:

The combination of Berenson and Bruette discloses the elements of claims 5-7 as noted above and furthermore, Berenson discloses displaying the first program indicator and an indicator of the first category in a first row, and displaying the second program indicator and an indicator of the second category in a second row [Fig 7]

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Claim 10:

The combination of Berenson and Bruette discloses the elements of claim 5 as noted above and furthermore, Berenson discloses a list of recommended programs, wherein the list of recommended programs corresponds to programs recommended to the user by a third party [Fig 7, category 6, paragraph 83]

Claim 11:

The combination of Berenson and Bruette discloses the elements of claims 5 and 10 as noted above and furthermore, Berenson discloses receiving the list of recommended programs from a remote source [Fig 1, paragraph 33]

Claim 12:

The combination of Berenson and Bruette discloses the elements of claim 5 as noted above and furthermore Bruette discloses identifying a restricted program indicator, the restricted program indicator being selectable by the user; wherein the list of displayable program indicators does not include the restricted program indicator [col 4, lines 57-65]

Claim 13:

The combination of Berenson and Bruette discloses the elements of claims 5 and 12 as noted above and furthermore Bruette discloses removing the restricted program indicator from the list of displayable programs [col 4, lines 57-65].

Claim 14:

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The combination of Berenson and Bruette discloses the elements of claim 5 as noted above and furthermore Berenson discloses identifying a preferred program indicator, the preferred program indicator being selectable by the user, and the preferred program indicator corresponding to a program of interest selected by the user, wherein the list of displayable program indicators includes the preferred program indicator [Fig 1 and paragraphs 32-39]

Claim 15:

The combination of Berenson and Bruette discloses the elements of claims 5 and 14 as noted above and furthermore Berenson discloses adding the preferred program indicator to the list of displayable programs indicators [Fig 1 and paragraphs 32-39]

Claim 18:

The combination of Berenson and Bruette discloses the elements of claim 5 as noted above and furthermore, Berenson discloses wherein the plurality of category preferences are customizable by the user [paragraph 39].

Claim 20:

The combination of Berenson and Bruette discloses the elements of claim 19 as noted above and furthermore, Berenson discloses a list of recommended programs, wherein the list of recommended programs corresponds to programs recommended to the user by a third party [Fig 7, category 6, paragraph 83]

Claim 21:

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The combination of Berenson and Bruette discloses the elements of claims 19 and 20 as noted above and furthermore, Berenson discloses receiving the list of recommended programs from a remote source [Fig 1, paragraph 33]

Claim 23:

The combination of Berenson and Bruette discloses the elements of claims 19-21 as noted above and furthermore Bruette discloses removing the restricted program indicator from the list of displayable programs [col 4, lines 57-65].

Claim 24:

The combination of Berenson and Bruette discloses the elements of claims 19-22 as noted above and furthermore Berenson discloses identifying a preferred program indicator, the preferred program indicator being selectable by the user, and the preferred program indicator corresponding to a program of interest selected by the user, wherein the list of displayable program indicators includes the preferred program indicator [Fig 1 and paragraphs 32-39]

Claim 25:

The combination of Berenson and Bruette discloses the elements of claims 19-22 and 24 as noted above and furthermore Berenson discloses adding the preferred program indicator to the list of displayable programs indicators [Fig 1 and paragraphs 32-39]

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Claims 16, 17, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Berenson and Bruette and further in view of Pub No US 2002/0110353 issued to Potrebic et al (hereafter Potrebic).

Claim 16:

The combination of Berenson and Bruette discloses the elements of claim 5 as noted above but fails to disclose identifying a previously viewed program, the previously viewed program being associated with a target program indicator; locating the target program indicator in the list of displayable program indicators; and removing the target program indicator from the list of displayable program indicators. Potrebic discloses determining whether or not to delete the viewed portion [paragraph 77]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Berenson, Bruette and Potrebic to include identifying a previously viewed program, the previously viewed program being associated with a target program indicator; locating the target program indicator in the list of displayable program indicators; and removing the target program indicator from the list of displayable program indicators for the purpose of deleting a program which the user has already viewed. The skilled artisan would have been motivated to modify the above combination of references such that the viewer is spared the frustration of losing a time slot because the time slot has been assigned to a previously viewed program which is of no interest to the viewer.

Claim 17:

The combination of Berenson and Bruette discloses the elements of claim 5 as noted above but fails to disclose identifying a previously viewed program, the previously viewed program being associated with a target program indicator; locating the target program indicator

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in the list of displayable program indicators; and assigning a low display priority to the target program indicator included in list of displayable program indicators. Potrebic discloses determining whether or not to delete the viewed portion [paragraph 77]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Berenson, Bruette and Potrebic to include identifying a previously viewed program, the previously viewed program being associated with a target program indicator; locating the target program indicator in the list of displayable program indicators; and assigning a low display priority to the target program indicator included in list of displayable program indicators for the purpose of assigning a low priority to a program which the user has already viewed. The skilled artisan would have been motivated to modify the above combination of references such that the viewer is given the choice of once again viewing a previously viewed program in the event the viewer wants to see the program again because the viewer highly enjoyed the first viewing.

Claim 26:

The combination of Berenson and Bruette discloses the elements of claims 19-22 and 24 as noted above but fails to disclose identifying a previously viewed program, the previously viewed program being associated with a target program indicator; locating the target program indicator in the list of displayable program indicators; and removing the target program indicator from the list of displayable program indicators. Potrebic discloses determining whether or not to delete the viewed portion [paragraph 77]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Berenson, Bruette and Potrebic to include identifying a previously viewed program, the previously viewed

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program being associated with a target program indicator; locating the target program indicator in the list of displayable program indicators; and removing the target program indicator from the list of displayable program indicators for the purpose of deleting a program which the user has already viewed. The skilled artisan would have been motivated to modify the above combination of references such that the viewer is spared the frustration of losing a time slot because the time slot has been assigned to a previously viewed program which is of no interest to the viewer.

Claim 27:

The combination of Berenson and Bruette discloses the elements of claim 5 as noted above but fails to disclose identifying a previously viewed program, the previously viewed program being associated with a target program indicator; locating the target program indicator in the list of displayable program indicators; and assigning a low display priority to the target program indicator included in list of displayable program indicators. Potrebic discloses determining whether or not to delete the viewed portion [paragraph 77]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Berenson, Bruette and Potrebic to include identifying a previously viewed program, the previously viewed program being associated with a target program indicator; locating the target program indicator in the list of displayable program indicators; and assigning a low display priority to the target program indicator included in list of displayable program indicators for the purpose of assigning a low priority to a program which the user has already viewed. The skilled artisan would have been motivated to modify the above combination of references such that the viewer is given the choice of once again viewing a previously viewed

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program in the event the viewer wants to see the program again because the viewer highly enjoyed the first viewing.

### *Response to Arguments*

Applicant's arguments filed 12/8/2005 have been fully considered and not found persuasive for the reasons given below.

#### **Applicant Argues:**

Applicant states in the following in the third paragraph of page 1:

Relative to claim 1, although applicants do agree with the Office Action – in so far as the Office Action recognizes that Berenson fails to disclose “retrieving a list of restricted program indicators” -- Applicants disagree that Berenson teaches “generating a list of displayable program indicators” that does not include program indicators “in the list of restricted program indicators.” Specifically, the recited “list of displayable program indicators” is generated so as to exclude “the list of restricted program indicators. Applicants submit that because Berenson does not teach a “list of restricted program indicators “ it cannot exclude “the list of restricted program indicators” fro the “displayable program indicators” as recited in independent claim 1.

#### **Examiner Responds:**

Examiner is not persuaded. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, Berenson discloses channels which are eliminated from the recommended channels because a user has explicitly designated such channels as “do not show me” (paragraph 39). At the time of the invention, one of ordinary skill in the art would have been motivated to combine a “list of recommended program indicators” as taught by Berenson with a list of “restricted program indicators” as taught by Bruette [col 4, lines 50-65] because restricted programs are obviously not a recommended programs and thus restricted programs should not be included in the list of recommended programs.

**Applicant Argues:**

Applicant states in the second paragraph of page 11 “as a consequence, neither Bruette not Berenson teach the recited “generating a list of displayable program indicators which excludes program indicators from the ‘list of restricted program indicators.’”

**Examiner Responds:**

Examiner is not persuaded. Bruette discloses the following:  
column 4, lines 57-65:  
More specifically, when commanded to generate the program guide, microprocessor 15 reviews all programs to be included in the guide. If any of the programs are restricted under either of the foregoing methods, the microprocessor 15 generates a "lock" icon 50 and functions to display the icon adjacent any restricted program, as shown in FIG. 3. The "lock" icon is stored as part of the aforementioned font table, and is recalled by the microprocessor 15 as required. The microprocessor 15 combines the data representing the icon with the program information associated with the restricted program, and then converts the combined data into displayable graphics data. As stated above, the displayable graphics data is then coupled to the MPEG chip 22 and subsequently displayed

Bruette inherently discloses a “list of restricted program indicators” because Bruette discloses that microprocessor 15 reviews all programs to be included in the guide. If any of the

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programs are restricted under either of the foregoing methods, the microprocessor 15 generates a 'lock' icon 15 and functions to display the icon adjacent any restricted program as shown in Figure 3. In order to display the lock icon 15 against a program, the microprocessor must have a list of restricted program indicators.

**Applicant Argues:**

Applicant states in the third paragraph of page 11

Finally, Applicants submit Bruette actually teaches away from "displayable program indicators" that do not include indicators "in the list of restricted program indicators." Specifically, Bruette teaches that it is advantageous to display their restricted programs along with unrestricted programs (as depicted in Figs 2 and 3 of Bruette).

Bruette, Col 5, lines 38-45

Most importantly, in the exemplary embodiment described above, the present invention allows the viewer to readily and easily identify if a program or channel has been restricted from viewing. As a result, the viewer has ready access to all available programs, and can modify the restricted list if he/she desires to view a restricted program

**Examiner Responds:**

Examiner is not persuaded. Examiner wishes to thank applicant for the above reference wherein Bruette clearly discloses a list of restricted programs. Applicant obviously has answered Applicant's previous comment that Bruette does not disclose a "list of restricted program indicators." Furthermore, examiner is confused by Applicant's assertion that Bruette teaches away from the claimed invention because Bruette specifically discloses that the "restricted program indicators" are **not** (emphasis added) included in the "list of recommended program

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indicators” because the user can readily and easily identify a recommended program or channel and a restricted program or channel.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on 8:00-4:30.

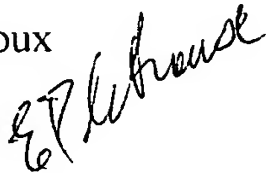
If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

2/1/2006

A handwritten signature in black ink, appearing to read "Etienne LeRoux", written over the printed name and date.